

REMARKSI. Status of the Claims

Claims 1, 2, 4, 9, 10 and 12 remain pending in the application. Claims 1 and 9 are independent claims. Claims 3 and 11 have been cancelled. Claims 1, 4, 9 and 12 have been amended to more clearly define the invention. No new matter has been added.

II. Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected all of the pending claims under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 97/16075 (Ream) in view of WO 91/01884 (Redford) or vice versa, further in view of U.S. Patent No. 5,423,252 (Yamamoto) and U.S. Patent No. 4,578,273 (Krubert) for the reasons set forth in the December 31, 2001 Office Action (Paper No. 12). Applicants respectfully request reconsideration in light of the above amendment and in view of these remarks.

As amended, claim 1 recites that the printing surface on the edible substrate is non-planar. This does not raise new issues because previously this was a dependent claim limitation. Applicants submit that none of the cited references alone or in combination teaches or renders obvious printing multicolor registered images on the non-planar surfaces of edible substrates.

The previous Office Action (Paper No. 12) indicated that "even if the claims were amended to impart some curved or non planar shape to the shaped piece, applicants are not the first to print on curved pieces and they are not the first to perform a dual operation on curved pieces." (Emphasis added). Whether or not this statement is correct, the prior art of record in this application does not disclose printing multicolor registered images on non-planar surfaces of edible substrates.

Ream discloses printing multicolor images on flat substrates. For example, at page 6: "For each product there is a package containing one or more generally flat, rectangular chewing gum pieces. . ." The description at page 9 recites: "a flat rectangular sheet of a chewing gum." Nothing in Ream suggests that the other food items mentioned at page 6 (taffy, gummy candy, and dehydrated fruit based confections) would have anything other than a flat printing surface. Nor is there any support for the statement in the Office Action that such items are "usually not slab shaped." Moreover, the apparatus disclosed in Ream does not appear to be capable of handling anything other than sheets.

Ream also does not hold pieces in a recess in registration. The recesses in which the gum sheets are placed are larger than the sheets (Ream, page 9), and as the sheets are conveyed through the apparatus, a guide rail 69 slides the sheets on the conveyor bed to align them for printing (Ream, page 16). Thus, although Ream discloses multicolor printing, the disclosure is limited to flat pieces and does not disclose holding the pieces in registration in a recess. If a vacuum were placed underneath the conveyor to remove starch dust, as contemplated at page 20 of Ream, it would be applied between the slats 52 of the conveyor. However, it would not tend to hold the pieces in registration and there is no indication in Ream that the vacuum is provided for that purpose.

In the Office Action, Redford is cited for the proposition that it is known to hold pieces in registration between printing stations. However, although Redford is said to contain disclosure relevant to printing registered images, the entire thrust of Redford is to avoid the use of offset printing to form complex images. Redford claims that offset printing on tablets causes problems such as smudging, fading and inaccurate positioning of the image (see Redford page 3, discussing the prior art). Thus, instead of printing a detailed image (much less a multicolored registered image), Redford uses a laser etching

technique, which permits forming a sharp image without having to print a complex image. See, for example, page 4 ("permits creation of much more distinctive and unique marking then would otherwise be possible using solely offset printing techniques"), and page 10 ("provides a capability which is not possible using tablet ink-printing techniques.")

The motivation for combining multicolor printing (Ream) with non-planar pieces held in registration (Redford) is entirely lacking from the references. The motivational statement in the Office Action is that:

Redford can be relied on to teach that when one desires to process shaped edible pieces on which two coordinated processes are to be performed on the edible pieces in a registered or precise fashion, it was well established in the art to transport the pieces from one station to the other station wherein a differential pressure is applied to maintain the pieces in a set position in a transporting recess.

(Paper No. 12, page 3). However, Redford does not actually say that. To the contrary, Redford discloses that offset printing of complex images on tablets results in inferior images, and that it is preferable therefore to print a background followed by etching the image.

Under 35 U.S.C. § 103(a), for a prima facie case of obviousness relying on a combination of references, the law requires a motivation in the prior art that would lead one of ordinary skill in the art to make the combination. The purpose of this requirement, repeatedly emphasized by the Federal Circuit in current decisions, is to prevent "hindsight" rejections; where every advancement in the art seems obvious once the problems are laid out and the solution set forth in the applicant's specification is used as a blueprint. Thus, a rejection under 35 U.S.C. § 103 must find specific motivation for the combination made. See In re Werner Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) ("[A] rejection cannot be predicated on the mere identification . . . of individual

components of claimed limitations. Rather particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.")

In the present case, the Examiner relies on Redford to teach that it was known to hold a non-planar piece in registration between two "printing" stations. This is an inappropriate use of Redford, which clearly implies that printing of complex images on such substrates cannot be readily accomplished with even one printing station. Meanwhile, registration does not appear to be an issue with the planar substrates of Ream.

The secondary references do not overcome the deficiencies noted above. Yamamoto does not disclose two printing stations, registration of pieces between printing stations or the printing of a multicolor registered image. The Examiner correctly notes that Yamamoto teaches pockets or recesses for holding tablets, and that vacuum is applied through device 121 to hold the tablets during printing. However, the "air absorption device" 121 is stationary, and therefore once the piece passes the device 121, the pieces are not held in place at all, and certainly not in registering relationship between two printing stations. Yamamoto is discussed in the specification at page 6, and the characterization there is accurate. The assertion of the Examiner, that the teachings of Yamamoto would readily be applied to an application where multicolor registered images were formed at two printing stations is without foundation in Yamamoto or any other prior art of record.

Krubert, similar to Ream, teaches forming images on generally planar food items. There is no discussion of registration and this concept does not appear to be relevant to the Krubert disclosure, where the food items are disclosed as being placed individually and manually on a mandrel prior to printing (see Krubert col. 3, lines 45-46). As with


Ream, nothing in the reference suggests modifications to accommodate a system where the pieces need to be held in registration utilizing recesses using vacuum.

Certain modifications to the claims have been introduced responsive to the Examiner's comments in an effort to clarify the record. For example, the Examiner alleged that "the claims are silent as to multicolor images" (Paper No. 12, page 4). As amended, instead of "multiple" images in registration, the claims recite multicolor images.

Applicants understand that this is substantially the same thing: the images are produced by multiple applications of coloring medium in registration with one another (first and second color). It is not believed that any of the foregoing amendments to the claims raises a new issue requiring further search and/or consideration. Applicants respectfully request entry and consideration of this amendment as placing the application in condition for allowance. At a minimum, entry of the amendment is requested as placing the application in better condition for appeal.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should be directed to our address given below.

Respectfully submitted,


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